



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Schwab et al

Serial No.: 09/877,628

Group No.: 2654

Filed: June 8, 2001

Examiner: Chawan

For: DATA TRANSMISSION SYSTEM WITH ENHANCEMENT DATA

APPELLANTS' BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Barry H. Schwab and John G. Posa, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 4 claims. Claim 2 was canceled by amendment in March 2005. Claims 1, 3 and 4 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a method of enhancing an electronic communication, comprising the steps of transmitting and receiving a message or file having a content; and storing, at the location of a recipient, enhancement information enabling the recipient of the message or file to more fully appreciate the content. (Specification, page 2, lines 1 to 5).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 3 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,802,314 to Tullis et al.¹

VII. ArgumentClaim 3

Claim 3, which adds to claim 1 the limitation of "enhancement information [that] enables the recipient to visualize the sender or listen to the content of a message," stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,802,314 to Tullis et al. In rejecting this claim, the Examiner cites Col. 14, line 59 to Col. 15, line 6 of Tullis, which reads as follows:

"In particular, it is possible to convert a limited vocabulary of voice information into text information through speech recognition techniques, and it is possible to convert text information into voice information through speech synthesis techniques depicted, for example, with respect to voice digitizer/synthesizer 45. In the case of facsimile or other image transmission of text, it is possible to perform optical character recognition on the image information to convert the image information to text information. It is further possible to convert text information to image information for transmission via facsimile or otherwise. In step S1118, CPU 40 provides for the desired conversions and, for example, provides for the conversion of image information of text into text information and further conversion of the text information to voice-synthesized information."

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v.

¹ Appellants are appealing only claims 3 and 4 at this time. Cognizant that they are dependent claims, Appellants will place these into independent form if/when either are allowed.

Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). In this case, the reference does not teach or even suggest the limitation of "enhancement information [that] enables the recipient to visualize the sender or listen to the content of a message." Accordingly, anticipation has not been established.

Claim 4

Claim 4, which adds to claim 1 the limitation of "enhancement information includes phonemes enabling the recipient to listen to the content in a synthesized voice of the sender," stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,802,314 to Tullis et al. In rejecting this claim, the Examiner cites Col. 4, lines 16-41 of Tullis, which reads as follows:

"In another aspect, the invention is a method and apparatus for handling multimedia messages in which a keyboard inputs text information, a microphone inputs voice information, a scanner inputs image information, and binary means inputs binary information. The text information, voice information, image information, binary and OLE information may be mixed to generate a multimedia message such that the different types of information are separately identifiable, and the multimedia message so generated is stored. Image information is sent and received via a facsimile interface, voice information is sent and received via a voice synthesizer/digitizer, and image information, text information, voice information, binary information and multimedia messages are sent and received via a modem. Multimedia messages received from the modem are stored, and the facsimile interface, the voice synthesizer/digitizer and the modem are controlled in accordance with message characteristics on the telephone interface by a network control unit. The multimedia message may include header information as well as one or more pages, each page having link information to other pages and map information which identifies the mixed types of information on the page. Conversion may be provided from one type of information to another and remote access to the message handling capabilities may be provided. The multimedia message may be displayed in a multimedia format and the displayed message may be edited."

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v.

Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). In this case, the Examiner argues that the reference discloses "phonemes enabling the recipient to listen to the content in a synthesized voice of the sender." However, as the Board can clearly see, such is not the case. Although voice synthesis is discussed, the references fails to teach of suggest any capability of synthesizing *the voice of the sender*. Accordingly, anticipation has not been established.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

John G. Posa
Reg. No. 34,424
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C.
PO Box 7021
Troy, MI 48007-7021
(734) 913-9300

Date: November 30, 2005

APPENDIX A

CLAIMS ON APPEAL

1. A method of enhancing an electronic communication, comprising the steps of:
transmitting and receiving a message or file having a content; and
storing, at the location of a recipient, enhancement information enabling the recipient of the message or file to more fully appreciate the content.
3. The method of claim 1, wherein the enhancement information enables the recipient to visualize the sender or listen to the content of a message.
4. The method of claim 1, wherein the enhancement information includes phonemes enabling the recipient to listen to the content in a synthesized voice of the sender.

Serial No. 09/877,628

- 6 -

53011aka

APPENDIX B

EVIDENCE

None.

Serial No. 09/877,628

- 7 -

53011aka

APPENDIX C

RELATED PROCEEDINGS

None.